REMARKS

Claims 1, 3 and 5 have been amended. Claims 1-8, 12 and 13 are all the claims pending in the application.

Claim rejections -- 35 U.S.C. § 103

Claims 1 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,909,210 to Knox. Applicant respectfully traverses this rejection.

In the November 10, 2005 Amendment Under 37 C.F.R. § 1.111, Applicant argued that Knox does not teach that the two functions are *effected by* certain keys on the keyboard. (See November 10, 2005 Amendment, at page 7). In response, the Examiner argues as follows:

> The Examiner respectfully disagrees, as discussed above, two functions, i.e.: cursor positional function and typing function, effected by certain keys of the keyboard, when the device is [sic] in cursor position operational mode the, certain keys of the keyboard cannot be used for typing function, and when the typing function activated by the sensor, the *positional function of the keyboard* cannot be used. (Response to Arguments, page 12, March 28, 2006 OA, emphasis added).

Applicant draws the Examiner's attention to the emphasized portion of the Examiner's own remarks, because this text illustrates the fundamental error in the Examiner's reasoning. The positional function in Knox is effected by the movement of the user's fingers over *the keyboard.* In other words, the positional function is not effected *by the keys* of the keyboard, as required by the claim. For Knox to teach the feature recited in the claim (which Knox does not), Knox would have to show that 1) the typing function is effected by certain keys AND 2) the positional function is effected by certain keys. This latter feature is not shown by Knox. The positional function is not a function which is performed under normal operation by the keys on

the Knox keyboard. In order to advance prosecution of the case, Applicant has amended claim 1 in order to make this distinction more clear. Therefore, independent claim 1 is patentable over Knox.

Independent claim 1 also recites the feature that a sensor detects a hand of a user or a proximity of the hand at a home position. The Examiner admits that Knox does not expressly teach that the sensor detects the hands of a user at the home position. Rather, the Examiner argues that Knox teaches that when multiple fingers are detected by a sensor, the mode changes to typing mode, and then extrapolates multiple fingers would be detected when the user is about to start typing. Finally, the Examiner argues that when the user is about to start typing, the user's hands are in home position. In essence, the Examiner argues that the sensing a hand at a home position feature of claim 1 is inherent in the Knox teachings. However, Applicant respectfully disagrees.

To prove that Knox discloses that "a sensor detects a hand of a user or a proximity of the hand at a home position," the Examiner must argue that the feature is "inherent." The question of whether a claim limitation is inherent in a prior art reference is a factual issue. See, *Continental Can Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). The doctrine of inherency allows for "modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference." *Id.* at 1269. "It is not, however, a substitute for determination of patentability in terms of § 103." *Id.* Although extrinsic evidence may be consulted regarding an asserted inherent characteristic, "[s]uch evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so

recognized by persons of ordinary skill." *Id.* at 1268 (emphasis added). Moreover, inherency "may not be established by probabilities or possibilities." *Id.* at 1269. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient," and expert testimony cannot be used to fill in the evidentiary gaps of an otherwise lacking prior art reference. *Motorola Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473 (Fed. Cir. 1997), citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983) (reversing trial court's judgment of invalidity because expert's testimony of inherent anticipation, unsupported by the evidentiary record, cannot serve as a basis for a finding of anticipation).

If a structure in a cited reference does not expressly disclose a claimed feature, but absolutely must include that claimed feature in order to function properly, then that feature is deemed to be inherently disclosed. See, e.g., *W.L. Gore*, 721 F.2d at 1554 ("[W]e are not persuaded that the "effect" of the processes disclosed in Smith and Sumitomo, an "effect" undisclosed in those patents, would be always to inherently produce or be seen always to produce products meeting all of the claim limitations.") In other words, if there are two or more possibilities with respect to the non-disclosed feature, then the non-disclosed feature is not inherent.

Knox discloses switching between a typing function and a positional function based on sensing and distinguishing between multiple fingers or a single finger. A single finger would trigger the positional function, while multiple fingers would activate the keys. However, as admitted by the Examiner, Knox does not disclose placing the fingers on a home position or near a home position, but only that multiple fingers are detected. The Examiner will appreciate that

multiple fingers may be detected at locations other than the home position, for example, at the number keys across the top of a conventional keyboard or at the function keys of a keyboard. Moreover, Applicant notes that Knox does not disclose keys having any particular assignment to letters or numbers, but only generic "keys" indicated by reference number 90 in Fig. 3. A home position is not contemplated or disclosed by Knox because Knox is concerned with having to move hands from the keys to a trackball or mouse or joystick, i.e. with a general movement of the hands away from the keyboard. For these reasons, a sensor that "detects a hand of a user or a proximity of the hand at a home position" is not inherent in Knox. Therefore, Knox does not disclose all of the features recited in claim 1, and claim 1 is patentable over Knox.

Claim 12 recites substantially similar features to those of claim 1, discussed above, and therefore claim 12 is patentable over Knox for the same reasons.

Claim rejections -- 35 U.S.C. § 103

Claims 2 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatnetalbe over Knox in further view of U.S. Patent No. 6,396,483 to Hiller.

Claims 2 and 13 depend from claims 1 and 12 which have been shown above to be patentable over Knox. Hiller does not cure the deficiencies of Knox. Therefore, claims 2 and 13 are patentable over the Knox and Hiller combination.

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,864,334 to Sellers in view of Knox.

The Examiner suggests that the limitation "any one of two functions effected by certain keys on a keyboard" is met by Sellers at col. 5, lines 57-59 and Fig. 1, #29. Applicant respectfully disagrees.

At col. 5, lines 57-59, Seller teaches switchable typing and cursor control modes, and keys in various positions on a keyboard, as shown in Fig. 1 at #29. This teaching is essentially the same as in Knox, discussed above. However, Sellers fail to teach that these functions are "effected by" the certain keys. While the typing function is effected by keys, the positional function of Sellers is not. In order to advance prosecution in the case, Applicant has amended claims 3 and 5 in order to make this distinction more clear. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Moreover, the Examiner admits that Sellers does not teach that the sensor detects whether hands of a user are present at a home position. However, the Examiner then appears to rely on Knox for teaching this feature, arguing that it would have been obvious to one having skill in the art to use "Knox's teaching of having the switching to one of the two functions carried out by detecting the user's hand in home position". Applicant notes that the Examiner admitted on page 4 that Knox does not explicitly teach the sensing hands at a home position feature. Instead, the Examiner argued that this feature is inherent. However, as discussed above, the feature of sensing hands at a home position is not inherent in Knox, nor in Sellers, as admitted by the Examiner. Therefore, claims 3 and 5 are patentable over the Sellers/Knox combination for this additional reason.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hiller in view of Knox.

Independent claim 7 and dependent claim 8 recite, *inter alia*, the feature of a control section for disabling an input by the second group of keys when the sensor detects a hand. The Examiner suggests that the claim limitation of a control section "for disabling the input of the second group of keys" is met by Hiller by virtue of the teachings at col. 2, lines 51-54 and col. 3, lines 19-22. Applicant respectfully disagrees.

At col. 2, lines 51-54, Hiller teaches an I/O controller that includes circuitry to enable the virtual keypad to act in one mode as a virtual numeric keypad and in another as a mouse. Thus, Hiller teaches switching between two modes -- virtual keypad and mouse. The Examiner will appreciate that in Hiller the virtual pad is always on. Hiller thus fails to suggest a control section that as a result of a sensor disables an input of a second group of keys.

In the response to arguments section, the Examiner states that "Knox discloses disabling the input of the group of keys of the keyboard by the sensor". (see FOA, page 12). However, Applicant can find no such teaching in Knox. At col. 11, lines 19-41, Knox discloses that when the user is finished using the digitizer, the digitizer is deactivated, and further that firmware could be provided to activate and deactivate the digitizer. However, these teachings do not disclose disabling the input of a group of keys. Nor is such disabling inherent. Thus, Knox does not remedy the deficiency of Hiller. As such, claims 7 and 8 are patentable over the Hiller/Knox combination.

Claims 4 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sellers and Knox in view of Hiller.

Claims 4 and 6 depend from claims 3 and 5, which have been shown above to be patentable over the Sellers and Knox combination. Hiller does not cure the deficiencies of Sellers and Knox. Therefore, claims 4 and 6 are patentable over the Sellers/Knox/Hiller combination.

Applicant therefore respectfully requests the Examiner to withdraw the § 103 rejections.

Obviousness-type double patenting

Claims 1-8 and 12-13 stand rejected on the alleged ground of nonstatutory double patenting over claims 1-3 of U.S. Patent No. 6,679,054.

To establish a prima facie case of obviousness-type double patenting, it is incumbent on the Examiner to determine the scope and content of a application claim relative to a claim in the application at issue, determine the differences between the scope and content of the claims, determine the level of ordinary skill in the art, and evaluate any objective indicia of non-obviousness. Specifically, the Examiner must delineate differences between the inventions as defined by the *conflicting claims*, and provide reasons why one skilled in the art would conclude that the invention defined in the claim at issue would have been obvious. The disclosure of the patent may not be used as prior art. See MPEP § 804(II)(B)(1). The Examiner has made broad assertions regarding the "subject matter" of the invention without comparing all of the elements of specific claims from the two applications. Applicant notes that claim 7 of the pending application recites other limitations which are non-obvious from claim 1 of USP 6,697,054. This

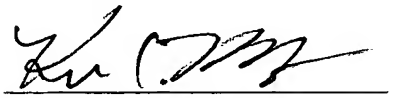
amounts to using the specification as prior art, and is legally improper. Thus, Applicant respectfully submits that the Examiner has not made out a prima facie case of non-statutory obviousness-type double patenting, and therefore the rejection is legally improper and must be withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Kevin C. Kunzendorf
Registration No. 58,308

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 23, 2006